Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

RE: TRADEMARK APPLICATION OF PETITE SUITES, INC.
Serial No. 73-721,257
October 2, 1991
***1** Petition Filed: April 18, 1991

For: WOOLLEY'S PETITE SUITES
Filing Date: April 8, 1988

Attorney for Petitioner

Keith W. Medansky

Rudnick & Wolfe

Jeffrey M. Samuels

Assistant Commissioner for Trademarks

On Petition

Petite Suites, Inc. has petitioned the Commissioner for an order reopening prosecution of the referenced application, following issuance of a final decision by the Trademark Trial and Appeal Board disposing of an ex parte appeal. Review of the petition is undertaken pursuant to authority provided in Trademark Rules 2.142(g) and 2.146(a)(2), 37 C.F.R. § § 2.142(g) and 2.146(a)(2).

FACTS

In the initial Office action issued during prosecution of petitioner's application, the examiner refused registration of the mark pursuant to Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), on the grounds that petitioner's mark is primarily merely a surname. The examiner noted that neither the use of the surname WOOLLEY in a possessive form nor the coupling of the surname with descriptive or generic matter was sufficient to overcome the primary significance of the mark as a surname. Petitioner was offered the option of converting the application to seek registration of the mark on the Supplemental Register.

Also in the initial Office action, the examiner required petitioner to enter a disclaimer of the word SUITES. However, when the disclaimer was provided in the response to that action, it was refused. The examiner's second Office action noted that the disclaimer would be accepted only upon amendment of the application to the Supplemental Register. The second action also contained a refusal of registration issued pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and maintained the refusal of registration under Section 2(e)(3).

Petitioner's response to the second Office action included a disclaimer of PETITE SUITES, and provided information necessary to overcome the refusal of registration issued under Section 2(d). The examiner, in turn, issued a third Office action, stated to be a "final" action. The refusal of registration under Section 2(e)(3) was maintained and entry of the disclaimer of PETITE SUITES was refused. Again, entry of the proffered disclaimer was refused pending amendment of the application to the Supplemental Register.

Petitioner then filed an appeal with the Trademark Trial and Appeal Board. In its appeal brief, petitioner argued against the examiner's refusal of registration under Section 2(e)(3) and also sought to retract the disclaimer of PETITE SUITES. In regard to the disclaimer issue, petitioner noted that the examiner had never expressly required entry of a disclaimer of anything other than SUITES and had never provided evidence showing that PETITE SUITES was descriptive or generic.

***2** The examiner sought, and obtained, a remand of the application from the Board for entry of evidence establishing the descriptive nature of PETITE SUITES. After filing of the examiner's appeal brief and petitioner's reply brief, the Board decided the case. In a decision issued March 19, 1991, the refusal of registration was upheld on the theory that PETITE SUITES had been shown to be a common descriptive term and its coupling with WOOLLEY'S did not obviate the primary significance of WOOLLEY as a surname.

On April 18, 1991, the instant petition was filed. Its final sentence requested the Commissioner to stay the time for petitioner to file a notice of appeal from the Board's order, pending a decision on the petition. The stay was approved by the Deputy Solicitor, providing petitioner with one month, following the issuance of this decision, to file any necessary notice of appeal with the U.S. Court of Appeals for the Federal Circuit.

BASIS FOR THE PETITION

Petitioner notes that its mark, during the pendency of the appeal to the Board, "achieved its fifth anniversary of use entitling it to the presumptions of prima facie distinctiveness under Section 2(f)." Petitioner also notes that the Board did not adjudicate the registrability of the mark under Section 2(f), and that the Commissioner has the authority to reopen the application and remand it to the examiner, "to entertain the proposed amendment" to proceed under Section 2(f).

The examiner, and her Managing Attorney, according to petitioner, have verbally indicated that they would approve publication of the referenced mark if petitioner filed an amendment (1) "converting the application to Section 2(f)" and (2) entering a disclaimer of PETITE SUITES. Finally, petitioner has indicated its willingness to file such an amendment.

DECISION

Trademark Rule 2.146(a)(2) provides that a petition to the Commissioner may be taken whenever specifically provided for by other provisions of the Trademark Rules. In turn, Trademark Rule 2.142(g) provides authority for review of the instant petition. This latter rule provides: "An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer ... or upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated."

A proposed amendment to an application, serving as the basis for a petition to reopen prosecution, must essentially place the application in condition for publication "subject only to an updating search" and not require further examination by the Examining Attorney. In re Vesper Corp., 8 U.S.P.Q.2d 1788, 1789 n. 3 (Comm'r Pat.1988). In this case, the petition has not actually been accompanied by a proposed amendment and has only referenced a willingness to supply an appropriate amendment. For this reason alone, the petition must be denied; if the petition were granted, the application would not be in condition for approval for publication. Compare In re Hickory Manufacturing Company, 183 USPQ 789 (Comm'r Pat.1974) (applicant had submitted amendment entering disclaimer; "no other examination would be required" and "subject to an updating search" the mark would be in condition for publication for opposition).

***3** Even if the particular "proposed amendment" contemplated by the petition had been submitted, the petition could not be granted. Under Rule 2.142(g), were the disclaimer of PETITE SUITES the only amendment that would need to be entered in petitioner's application to place it in condition for allowance by the examiner, the Board could have remanded the case without need for the instant petition. [FN1] This case, however, raises the additional question of whether prosecution could be reopened for consideration of an amendment that would not only enter a disclaimer but which would also amend the application to proceed under Section 2(f) of the Trademark Act.

In regard to petitioner's proposal to amend the application to proceed under Section 2(f), the following preliminary points must be noted: First, during the pendency of the appeal to the Board, based on the dates of use claimed in the application, petitioner's mark could only have reached its fifth anniversary of use; it could not have reached its fifth anniversary of use in commerce until more than two months after the filing of the petition. Second, Section 2(f) does not provide that a mere claim of five years of use of a mark establishes a presumption of acquired distinctiveness. Rather, Section 2(f) provides that if a claim of five years of "substantially exclusive and continuous use ... in commerce" is made, the claim may be accepted as prima facie evidence of acquired distinctiveness.

Presumably, the examiner's asserted willingness to approve the mark for publication under Section 2(f) is conditioned on entry of a statement of appropriate use in commerce, and not merely a statement of five years use of any type. While the petition clearly evidences a

willingness by petitioner to enter a claim of five years of use of its mark, it does not clearly evidence an equal willingness to enter a verified claim of five years of substantially exclusive and continuous use in commerce. Thus, it is not clear that petitioner is willing to enter the type of amendment that the examiner presumably contemplates receiving.

Further, it has been held that prosecution of an application will not be reopened to allow the filing of an amendment to convert the application to seek registration on the Supplemental Register. Ex parte Simoniz Company, 161 USPQ 365 (Comm'r Pat.1969); Ex parte Helene Curtis Industries, Inc., 134 USPQ 73 (Comm'r Pat.1962). "The nature of such a conversion" requires additional examination. Hickory Manufacturing, 183 USPQ at 790. In many respects, a conversion of an application from one seeking registration on the Principal Register to one seeking registration on the Supplemental Register can be considered similar to the conversion proposed in this case.

Both the Simoniz and Helene Curtis decisions placed great reliance on the fact that the respective petitioners would not be prejudiced by denial of their petitions, in terms of their ability to subsequently file new applications seeking registration of their marks on the Supplemental Register. Similarly, petitioner in this case is not prejudiced by this decision in any way and may freely seek registration on the Principal Register under Section 2(f) by filing a new application.

CONCLUSION

***4** The petition is denied. Petitioner is noted to have one month from the mailing date of this decision to file its notice of appeal with the U.S. Court of Appeals for the Federal Circuit, if it chooses to do so.

FN1. This was not always the case. An earlier version of the rule did not provide the Board with authority to remand an application for entry of a disclaimer. Thus, in In re Hickory Manufacturing Company, 183 USPQ 789 (Comm'r Pat.1974), a petition to the Commissioner was necessary for consideration of a request to remand for entry of a disclaimer that had been required by the examiner during prosecution and which was upheld by the Board on appeal.

21 U.S.P.Q.2d 1708

END OF DOCUMENT